



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/628,146	07/28/2000	Nicolas Javier Di Prinzio	102	3537

22197 7590 11/18/2004

GENE SCOTT; PATENT LAW & VENTURE GROUP
3140 RED HILL AVENUE
SUITE 150
COSTA MESA, CA 92626-3440

EXAMINER

HENDERSON, MARK T

ART UNIT	PAPER NUMBER
----------	--------------

3722

DATE MAILED: 11/18/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/628,146

Applicant(s)

DI PRINZIO, NICOLAS JAVIER

Examiner

Mark T Henderson

Art Unit

3722

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 September 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 20, 21 and 23-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 20, 21, 23-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 3722

DETAILED ACTION

Faxing of Responses to Office Actions

In order to reduce pendency and avoid potential delays, TC 3700 is encouraging FAXING of responses to Office Actions directly into the Group at (703)305-3579. This practice may be used for filing papers which require a fee by applicants who authorize charges to a PTO deposit account. Please identify the examiner and art unit at the top of your cover sheet. Papers submitted via FAX into TC 3700 will be promptly forwarded to the examiner.

1. Claims 20 and 21 have been amended. Claims 1-19 and 22 have been canceled.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Art Unit: 3722

Claims 20, 21, 23-30 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

2. Claim 20 recites the limitation "the sliding insertion" in line 19. There is insufficient antecedent basis for this limitation in the claim. Should this limitation state "the insertion"?
3. Claim 21 recites the limitation "the distal ends" in lines 14 and 15; and "the sliding insertion" in line 18. There is insufficient antecedent basis for this limitation in the claim.
4. Claim 23 recites the limitation "the folding line" in line 1. There is insufficient antecedent basis for this limitation in the claim.
5. Claim 24 recites the limitation "the folding line" in line 1. There is insufficient antecedent basis for this limitation in the claim.
6. Claim 25 recites the limitation "the structural disparity" in line 1. There is insufficient antecedent basis for this limitation in the claim.
7. Claim 26 recites the limitation "the structural disparity" in line 1. There is insufficient antecedent basis for this limitation in the claim.
8. Claim 27 recites the limitation "the opposite direction" in line 3. There is insufficient antecedent basis for this limitation in the claim.
9. Claim 28 recites the limitation "the opposite direction" in line 3. There is insufficient antecedent basis for this limitation in the claim.

Art Unit: 3722

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 20, 21, 23-26, 29, 30 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over Berglof et al (5,682,653) in view of Davison (3,529,328).

Berglof et al discloses in Fig. 1 and 2 and in Attachment I, a magnetic clip marker comprising: magnetic members (11, which have two on each side) each having a thickness; a pair of wall members (18A and 19A) of unequal length (Col. 3, lines 10-13) aligned (Col. 3, lines 20-23) at a throat (interior side of 13A in Fig. 1) to define a structure exhibiting an overlapped normal working position (due to the magnets constant attraction) with opposite surfaces (18B and 19B, see Attachment I) providing a continuous interior surface extending between the throat and terminal ends (A and B) of the wall members; with the wall members comprised of a base portion (19) adjacent terminal ends (A), and a clip portion (18) overlapping the base portion to define the throat (between the wall members) as a junction and structurally arranged to receive insertion of a page/sheet between the clip portion and the base portion until the edge of page/sheet engages the throat; the wall members supporting the magnetic members along the interior surface in aligned facing opposition to permit attraction and compression between the magnetic members;

Art Unit: 3722

and a continuous plastic cover member (C) disposed along the interior surface to form a continuous layer extending from a first terminal end (A), around the throat, to a second terminal end while covering and separating the magnetic members.

However, Berglof et al does not disclose: wherein the pair of wall members define an integral structure; and wherein the clip and base portions are arranged to receive insertion of a page of a book; a cover member disposed along the interior surface to form a continuous layer.

Davison discloses in Fig. 1 and 3, a magnetic clip comprising a separate wall member (9) connected to a separate continuous interior cover member extending from a first terminal end (5) to a second terminal end (6).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Berglof et al's magnetic clip with a connected wall and cover members as taught by Davison to provide an inner liner/layer which is supportive and non-abrasive to items inserted between the clip and base portions.

In regards to **Claims 20 and 21**, it would have been obvious to one having ordinary skill in the art at the time the invention was made to construct the wall members as an integral structure, wherein the throat is a junction (joining of two separate pieces), since it has been held that forming in one piece an article which has formerly been formed in two pieces and put together involves only routine skill in the art for the purpose of combining two distinctly constructed items. Therefore, the wall members and throat of the Berglof et al reference would continue to function the same if they had been constructed as a unitary product.

Art Unit: 3722

In regards to **Claims 20, 21, 25 and 26**, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. Therefore, the cover member of the Berglof et al reference is capable of receiving the insertion of any desired substrate between the wall members, cover members and magnets; and the longer length wall member is capable of providing a guiding means that facilitates insertion of a page.

In regards to **Claims 29 and 30**, it would have been an obvious matter of design choice to construct the wall member and cover member of any desirable dimension (thickness), since such a modification would have involved a mere change in the size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. Therefore, it would have been obvious to construct the wall members and cover member in any desirable thickness dimension, since applicant has not disclosed the criticality of having a particular thickness and invention would function equally as well if the cover member were constructed in any desirable thickness for the purpose of holding the inserted pages and offering a distinct separation means in which to reveal which pages have been bookmarked.

Art Unit: 3722

11. Claims 27 and 28 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over Berglof et al in view of Davison and further in view of Johnson (2,630,777).

Berglof et al as modified by Davison discloses a magnetic clip marker comprising all the elements as claimed in Claims 20 and 21, and as set forth above. However, Berglof et al does not disclose a portion which is part of the structure of the clip which extends in a linear way to one of the wall of the members and in a direction opposite to the throat of the structure of the clip.

Johnson discloses in Fig. 1 and 3, a clip marker having a portion (14) extending in a linear way to one of the wall members (10) and in a direction opposite to the throat (13) of the structure of the clip (A).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Berglof et al's clip marker with a linear extending portion as taught by Johnson for the purpose of providing the marker with an index marker.

Response to Arguments

12. Applicant's arguments with respect to Claims 20, 21, 23-30 have been considered but are moot in view of the new ground(s) of rejection.

In response to applicant's arguments that the Berglof et al reference does not disclose "a continues (assume applicant meant continuous) cover member, but rather defines a tubular

Art Unit: 3722

structure”, the examiner submits that the Berglof references as modified by Davison discloses a clip marker having a continuous but separate cover member, which is separate from the call member. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Berglof et al’s magnetic clip with a connected wall and cover members as taught by Davison to provide an inner liner/layer which is supportive and non-abrasive to items inserted between the clip and base portions.

In response to applicant’s argument that “it is not necessary to part the magnets in order to receive the sheet of paper, but rather, the two members need only be pushed onto the sheet of paper”, the examiner submits: 1) that the references fail to show certain features of applicant’s invention, it is noted that the features upon which applicant relies (it is not necessary to part the magnets to receive the paper) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims; 2) it is not understood how it is not necessary to part the magnetically attracted magnets to receive the paper since the attracted magnets are used to hold the sheets. One would have to separate the magnets to insert the sheet between the magnets.

Therefore, the examiner’s rejection has been maintained.

Art Unit: 3722

Conclusion

13. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Art Unit: 3722


Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark T. Henderson whose telephone number is (571)272-4477. The examiner can be reached on Monday - Friday from 7:30 AM to 3:45 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner supervisor, A. L. Wellington, can be reached on (571) 272-4483. The fax number for TC 3700 is (703)872-9306. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the TC 3700 receptionist whose telephone number is (703)308-1148.



MTH

November 12, 2004



A. L. WELLINGTON
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3700